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10/655,387

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EXAMINER

PYZOCHA, MICHAEL J

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/655,387	Applicant(s) RADATTI, PETER V.	
	Examiner MICHAEL PYZOSHA	Art Unit 2437	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/16/2010 has been entered.
2. Claims 1-37 are pending.

Claim Objections

3. The claim objections have been withdrawn based on the filed amendment.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 18-37 relate to methods for processing code however, these methods are not tied to a particular machine nor do they transform a particular article. As such these claims are directed to non-statutory subject matter. See *In re Bilski*. It is recommended to amend the claims to include some sort of device to tie to the method.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 6-8, 10, 11, 18-19, 21-25, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tso et al (US 6088803) in view of Engel et al. (US 6115393) and further in view of Lowell (US 6381632).

As per claims 1, 3, 11, 18, 34, and 36, Tso et al discloses an apparatus and method including a protocol parser; a protocol scanner; and, a proscribed code scanner comprised of a scanning means and an indicator whereby said protocol parser intercepts instant messaging or peer-to-peer code on a communications channel and transmits said code to said proscribed code scanner through said protocol scanner (see column 6 lines 10-24 where the parser performs the functions the protocol parser and the transcode service providers perform the function of the protocol scanner).

Tso et al. fails to explicitly disclose the protocol parser is capable of discriminating among different protocols implemented on top of the transport layer and fails to explicitly disclose the code is being communicated as a code stream on a communications channel.

However, Engel et al. teaches a protocol parser that discriminates between different protocols implemented on top of the transport layer (see column 19 line 53

through column 20 line 28 and FIG 2 and 19) and Lowell teaches monitoring data streams on a communications channel (see column 4 lines 38-58).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the protocol parser of Engel et al. as the parser of the Tso et al. system to parse streams of data on a communications channel.

Motivation to do so would have been to allow statistics, state tracking and tracing operations to be performed (see Engel et al. column 19 lines 35-63) and to monitor user activity on a network (see Lowell column 2 lines 29-56).

Furthermore, with respect to claim 1, the modified Tso et al., Engel et al. and Lowell system discloses the apparatus is configurable to process multiple code streams created when more than one communications channel is opened (see Lowell Fig. 3 and column 4 lines 4-27).

As per claims 2 and 19, the modified Tso et al., Engel et al. and Lowell system discloses a translation means whereby said translation means translates said code to authorized program parameters (see Tso et al. column 6 lines 10-24 and Engel et al. column 19 line 53 through column 20 line 28).

As per claim 4, 6, 23, the modified Tso et al., Engel et al. and Lowell system discloses the proscribed code scanner further comprises a scanning means and an indicator means and provide an indication of the presence is scanning finds proscribed code (see Tso et al. column 3 lines 39-54).

As per claims 7 and 25, the modified Tso et al., Engel et al. and Lowell system discloses the proscribed code scanner comprises a malicious code scanner (see Tso et al. column 3 lines 39-54).

As per claims 8, 10, and 24, the modified Tso et al., Engel et al. and Lowell system discloses the protocol parser further comprises a configuration means for configuring interception parameters (see Tso et al. column 6 lines 10-24 and column 5 lines 27-43).

As per claims 21-22, the modified Tso et al., Engel et al. and Lowell system discloses returning said code to a communication channel if said indicator is negative (see Tso et al. column 3 lines 55-65).

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable the modified Tso et al., Engel et al. and Lowell system as applied above, and further in view of Corliss (US 6771949).

As per claim 9, the modified Tso et al., Engel et al. and Lowell system discloses an apparatus for processing code comprising: a protocol parser capable of discriminating among different protocols implemented on top of the transport layer (see Tso et al. column 6 lines 10-24 and Engel et al. column 19 line 53 through column 20 line 28) and, a proscribed code scanner; whereby said protocol parser intercepts messaging code on a communications channel and transmits said code for review by said proscribed code scanner and said protocol parser being provided to parse protocols on top the transport layer (see Tso et al. column 6 lines 10-24 and Engel et al.

column 19 line 53 through column 20 line 28) where the communications are streams of data (see Lowell column 4 lines 38-58).

The modified Tso et al., Engel et al. and Lowell system discloses intercepting codes that are commonly passed over the Internet (see Engel et al. column 19 line 53 through column 20 line 28), but fails to explicitly disclose that the messaging code is short messaging code.

However, Corliss teaches sending short messages (SMS) over the internet (see column 3 line 57 through column 4 line 3).

At the time of the invention it would have been obvious to a person of ordinary skill in the art for the modified Tso et al., Engel et al. and Lowell system to intercept short messaging code.

Motivation, as recognized by one of ordinary skill in the art, to do so would have been to monitor SMS messages.

8. Claims 5, 12, 15-17, 20, 26-29, 32-33, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Tso et al., Engel et al. and Lowell system as applied to claims 1 and 18 above, and further in view of Johnson (US 5682428).

As per claims 12, 17, 26, and 35, the modified Tso et al., Engel et al. and Lowell system fails to disclose decrypting the code.

However, Johnson discloses decrypting data (see column 27 lines 23-56).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Johnson's method of decryption in the modified Tso et al., Engel et al. and Lowell system of code scanning.

Motivation to do so would have been to be able to reference and manipulate previously encrypted data (see Johnson column 27 lines 23-56).

As per claims 5 and 20, the modified Tso et al., Engel et al., Lowell and Johnson system discloses a certification means (see Johnson column 24 line 52 through column 25 line 8).

As per claims 15-16, 27-29, and 32, the modified Tso et al., Engel et al., Lowell and Johnson system discloses encrypting the code if the indication of a prescribed code is negative (see Johnson column 27 lines 23-56).

As per claim 33, the modified Tso et al., Engel et al., Lowell and Johnson system discloses a separate system inserted in said communications channel, and with at least one of said steps of intercepting said code; decrypting said code; scanning said code for the presence of proscribed code, and providing an indicator for the presence of said proscribed code, occurring on said separate machine (see Tso et al and Johnson as applied to previous claims).

9. Claims 13-14 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Tso et al., Engel et al., Lowell and Johnson system as applied to claims 12 and 26 above, and further in view of Elgamal et al (US 6389534).

As per claims 13-14 and 30-31, the modified Tso et al., Engel et al., Lowell and Johnson system fails to disclose the use of SSL or S/MIME encryption.

However, Elgamal et al discloses the use of these encryption techniques (see column 4 lines 15-29).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Elgamal et al's methods of encryption to perform the encryption of the modified Tso et al., Engel et al., Lowell and Johnson system.

Motivation to do so would have been to allow for the encryption suitable for each market (see Elgamal et al column 4 lines 15-29).

10. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Tso et al., Engel et al., Lowell and Johnson system as applied to claim 30 above, and further in view of Cogger et al. (US 20020087383).

As per claim 37, the modified Tso et al., Engel et al., Lowell and Johnson system fails to disclose intercepting with said parser a request from one or the other of an original client and an original server for an SSL transfer, creating with said parser a new SSL server that communicates with said client and a new SSL client that communicated with said server, and intercepting with said SSL client and said SSL server communications that occur between said original client and said original server.

However, Cogger et al. teaches such intercepting, decrypting and re-encrypting using SSL (see paragraph [0060]).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to perform the steps of Cogger et al. in the modified Tso et al., Engel et al., Lowell and Johnson system.

Motivation to do so would have been to verify a users session (see Cogger et al. paragraph [0060]).

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8, 10-12, 15-29 and 32-36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S.

Patent No. 7389540 in view of Engel et al. and Lowell.

The claims of '540 contain limitations of claims 1-8, 10-12, 15-19 and 32-36, but fail to explicitly disclose the protocol parser is capable of discriminating among different protocols implemented on top of the transport layer that intercepts instant messaging code where the communications are data streams.

However, Engel et al. teaches a protocol parser that discriminates between different protocols implemented on top of the transport layer (see column 19 line 53 through column 20 line 28 and FIG 2 and 19) and Lowell teaches intercepting data streams (see column 4 lines 38-58).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the protocol parser of Engel et al. as the parser of the '540 claims to parse data streams.

Motivation to do so would have been to allow statistics, state tracking and tracing operations to be performed (see Engel et al. column 19 lines 35-63) and to monitor user activity on a network (see Lowell column 2 lines 29-56).

12. Claim 9 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 7389540 in view of Engel et al. and Lowell as applied above and further in view of Corliss.

As per claim 9, the modified claims in view of Engel et al. and Lowell teach intercepting codes that are commonly passed over the Internet (see Engel et al. column 19 line 53 through column 20 line 28) where the codes are data streams (see Lowell column 4 lines 38-58), but fails to explicitly disclose that the messaging code is short messaging code.

However, Corliss teaches sending short messages (SMS) over the internet (see column 3 line 57 through column 4 line 3).

At the time of the invention it would have been obvious to a person of ordinary skill in the art for the modified system of the '540 claims in view of Engel et al. and Lowell to intercept short messaging code.

Motivation, as recognized by one of ordinary skill in the art, to do so would have been to monitor SMS messages.

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13. Claims 13, 14, 30 and 31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 7389540 in view of Engel et al. and Lowell as applied above and further in view of Elgamal.

As per claims 13-14 and 30-31 the modified claims in view of Engel et al. and Lowell fail to disclose the use of SSL or S/MIME encryption.

However, Elgamal et al discloses the use of these encryption techniques (see column 4 lines 15-29).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Elgamal et al's methods of encryption to perform the encryption of the modified claims in view of Engel et al. and Lowell.

Motivation to do so would have been to allow for the encryption suitable for each market (see Elgamal et al column 4 lines 15-29).

14. Claim 37 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 7389540 in view of Engel et al., Lowell and Elgamal as applied above and further in view of Cogger et al.

As per claim 37, the modified claims in view of Engel et al., Lowell and Elgamal system fails to disclose intercepting with said parser a request from one or the other of an original client and an original server for an SSL transfer, creating with said parser a new SSL server that communicates with said client and a new SSL client that communicated with said server, and intercepting with said SSL client and said SSL server communications that occur between said original client and said original server.

However, Cogger et al. teaches such intercepting, decrypting and re-encrypting using SSL (see paragraph [0060]).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to perform the steps of Cogger et al. in the modified system of the claims in view of Engel et al., Lowell and Elgamal.

Motivation to do so would have been to verify a users session (see Cogger et al. paragraph [0060]).

15. Claims 1-8 and 10-36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 7404212 in view of Engel et al.

The claims of '212 contain the limitations of claims 1-8 and 10-36, but fail to explicitly disclose the protocol parser is capable of discriminating among different protocols implemented on top of the transport layer that intercepts instant messaging code.

However, Engel et al. teaches a protocol parser that discriminates between different protocols implemented on top of the transport layer (see column 19 line 53 through column 20 line 28 and FIG 2 and 19) and Lowell teaches intercepting data streams (see column 4 lines 38-58).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the protocol parser of Engel et al. as the parser of the '212 claims to parse data streams.

Motivation to do so would have been to allow statistics, state tracking and tracing operations to be performed (see Engel et al. column 19 lines 35-63) and to monitor user activity on a network (see Lowell column 2 lines 29-56).

16. Claim 9 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 7404212 in view of Engel et al. and Lowell as applied above and further in view of Corliss.

As per claim 9, the modified claims in view of Engel et al. and Lowell teach intercepting codes that are commonly passed over the Internet (see Engel et al. column 19 line 53 through column 20 line 28) where the codes are data streams (see Lowell column 4 lines 38-58), but fails to explicitly disclose that the messaging code is short messaging code.

However, Corliss teaches sending short messages (SMS) over the internet (see column 3 line 57 through column 4 line 3).

At the time of the invention it would have been obvious to a person of ordinary skill in the art for the modified system of the '212 claims in view of Engel et al. and Lowell to intercept short messaging code.

Motivation, as recognized by one of ordinary skill in the art, to do so would have been to monitor SMS messages.

17. Claim 37 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 7404212 in view of Engel et al., Lowell and Elgamal as applied above and further in view of Cogger et al.

As per claim 37, the modified claims in view of Engel et al. and Elgamal system fails to disclose intercepting with said parser a request from one or the other of an original client and an original server for an SSL transfer, creating with said parser a new SSL server that communicates with said client and a new SSL client that communicated with said server, and intercepting with said SSL client and said SSL server communications that occur between said original client and said original server.

However, Cogger et al. teaches such intercepting, decrypting and re-encrypting using SSL (see paragraph [0060]).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to perform the steps of Cogger et al. in the modified system of the claims in view of Engel et al. and Elgamal.

Motivation to do so would have been to verify a user's session (see Cogger et al. paragraph [0060]).

Response to Arguments

18. Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tso, Housel and Ludtke teach methods of parse and monitoring data streams.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PYZOCHA whose telephone number is (571)272-3875. The examiner can normally be reached on Monday-Thursday, 7:00am - 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael Pyzocha/
Primary Examiner, Art Unit 2437